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In re Application of
Bruce et al.
Application No. 09/491,721
Filed: January 27, 2000
Attorney Docket No. 15838-211011/233USPT

: **OFFICE OF PETITIONS**
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: **DECISION GRANTING PETITION**
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This application has been referred back to this office by Technology Center 1700 for clarification, and upon careful reconsideration of the entire record, and with the approval of the Group Director, Technology Center 1700, the petitions filed September 8, 2003, and October 23, 2003, are collectively being treated as a petition under 37 CFR 1.181 (no fee) to withdraw the holding of abandonment.

The petition is **granted**.

The decisions of September 8, 2003, and November 5, 2003, are **vacated**.

BACKGROUND

A final Office action was mailed December 9, 2002, to counsel P. Weston Musselman, Jr. (Musselman), at the specified address: Jenkins and Gilchrist, 3200 Fountain Place, 1445 Ross Avenue, Dallas, Texas. As no reply within the meaning of 37 CFR 1.113 was filed, and no extensions of time were obtained, the application apparently became abandoned on March 9, 2003. A Notice of Abandonment was mailed July 31, 2003.

In reply on September 8, 2003, a petition was filed that requested, withdrawal of the holding of abandonment, or in the alternative, revival under 37 CFR 1.137(a). The petition was signed by Musselman, and asserted that the firm of Jenkins and Gilchrist had never received the aforementioned Office action, at the address to which the action had been mailed, and included a copy of that firm's docket records where the non-received communication would have been entered had it been received. The petition originated from Musselman's new firm and location: Fish and Richardson, 5000 Bank Center 1717 Main Street, Dallas Texas, and was accompanied by a revocation and power of attorney by the assignee of the entire interest. Under MPEP 324, the assignee revoked all previous powers and reappointed Musselman (and appointed others) at the new correspondence address. Furthermore, due to applicant's diligence, the petition also included a reply to the non-received final office action in an attempt to further prosecution.

The decision of September 30, 2003, apparently failed to recognize that (1) the petition was signed by counsel of record at the time of apparent abandonment, and (2) contained the requisite statement and showing as to non-receipt of the action at the address to which the Office action had been mailed, per MPEP 711.03(c)(II). The decision dismissed the petition to

withdraw the holding of abandonment, which pursuant to MPEP 1002.02(c) is decided by the Group Director of the Technology Center. The alternate petition for revival was likewise dismissed for the same reasons noted above.

A renewed petition was filed October 28, 2003. Musselman pointed out that he had been the attorney of record at the time of abandonment, which meant that the statement of non receipt had been made by the counsel of record at the time of abandonment that the showing of record pertained to the former mailing address, and as such the first petition to withdraw the holding of abandonment should have been granted.

The renewed petition was granted in the decision of November 5, 2003. The petition fees were refunded. The decision also held that the RCE was unnecessary and refunded the RCE fee. Unfortunately, the examiner had not been consulted by the Office of petitions to see if the reply *prima facie* placed the application in condition for allowance. But see MPEP 711.03(c)III(A)(2)(b).

On December 12, 2003, the examiner determined that the reply of September 8, 2003, did not *prima facie* place the application in condition for allowance. As such the RCE was necessary to maintain prosecution, and in turn the Technology Center queried this office as how to proceed further with this application.

OPINION

A correctly noted by counsel, the petition filed September 8, 2003, was grantable as filed. As such, upon favorable consideration of the petition by the Technology Center, the final Office action would normally be remailed, and the period for reply restarted. However, counsel had diligently obtained a copy of the non received Office action on August 25, 2003, to facilitate consideration of the petition, which rendered it unnecessary to remail the non-received Office action and restart the period. Then, if as here, the amendment did not *prima place* the case in condition for allowance, an Advisory action would have been mailed and, again as here, an RCE would have been filed requesting entry of the previously filed but on entered reply.

Therefore under the circumstances of this application, the record shows that the first time that the Office action of December 9, 2002, was "given or mailed" within the meaning of 35 U.S.C. § 133 to applicant was August 25, 2003, which in essence restarted the period for applicant to reply, given the adequate showing on non-receipt of the original mailing. The record further shows that applicant timely filed a reply under 37 CFR 1.113 and an RCE under 37 CFR 1.114, upon his having been given or mailed the Office action on August 25, 2003. Since the record further shows that the reply did not *prima facie* place this application in condition for allowance the RCE was required to maintain the pendency by withdrawing the finality of the outstanding office action.

DECISION

The holding of abandonment is being withdrawn by this office with the approval of the Group Director to facilitate treatment of this application. The decisions of September 30, 2003 and November 5, 2003, are ***vacated***.

This application is being returned to Technology Center 1700 to process the RCE request filed September 8, 2003, and charge the RCE fee.

Any inconvenience to applicant or the Technology Center is regretted.

Telephone inquiries related to this decision should be addressed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy